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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,562	11/01/2000	William C O'Neil, Jr.	TFUND-4809	3102
72960	7590	12/27/2007		
Casimir Jones, S.C. 440 Science Drive Suite 203 Madison, WI 53711			EXAMINER CHAMPAGNE, DONALD	
			ART UNIT	PAPER NUMBER
			3622	
			MAIL DATE	DELIVERY MODE
			12/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/703,562

Applicant(s)

O'NEIL, JR. ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-8,11-16,24,25,27,29-32 and 49-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-8,11-16,24,25,27,29-32 and 49-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 4 Dec 2007.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 31 October 2007 has been entered.

Response to the Declaration

Filed by Michael Thompson under 37 CFR 1.131

2. This declaration was filed as evidence that the instant invention was "invented" (arguments pp. 8-9) prior to the effective date of Bednarek (US006965868B1). This declaration is moot in view of the following new basis of rejection that does not rely on Bednarek.

Response to Arguments

3. Applicant's other arguments and declarations filed with an amendment on 31 October 2007 have been fully considered but they are moot in view of the following new basis of rejection.

Interview Results

4. During an interview on 4 December 2007, the examiner agreed to examine five potential claim limitations for possible patentability. None of the limitations were found to be promising, for reasons given at para. 15 below.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1, 4-8, 11-16, 24, 25, 27, 29-32 and 49-53 are rejected under 35 U.S.C. 103(a) as obvious over Lidman (US005471669A) in view of Schultz et al. (US pat. 5,056,019).¹

7. Lidman teaches (independent claims 1, 24, 49, 50 and 53) a method and a system, the method comprising:

a) providing:

i) a *purchaser* with an *account 50* (col. 2 lines 39-42), which reads on a registered member,

ii) at least one higher education account (the *account 50* and col. 1 lines 25-26 and 53-54),

iii) at least one registered merchant (*store 20* with *cash register 110*), which reads on a registered merchant (para. 8 below) *offering coupons* (col. 1 lines 53-56) which reads on rebates to said registered member, and

iv) a rebate network manager (whoever operates the Fig. 1 *coupon savings account system*, col. 2 lines 25-27, including *cash register 110*, col. 2 lines 42-44), wherein at least one registered merchant (the merchant operating *cash register 110*) is registered with said rebate network manager;

b) reading/entering coupon amounts (col. 2 lines 46-51), which reads on calculating a rebate on each purchase made by said registered member from said at least one registered merchant, wherein said rebate network manager/*cash register 110* reads the *purchaser/registered member account information* in conjunction with reading the purchases (col. 2 lines 52-54), which reads on monitoring sales by said registered merchant/*store 20* to determine if said sales are to said *purchaser/registered member*, and wherein said calculating step is performed by said rebate network manager/*cash register 110* utilizing a computer processor (*cash register 110*) configured to calculate said rebate based on an existing formula, wherein said rebate network manager then debits the account of the merchant (col. 4 lines 4-7); and

c) via a computer network (Fig. 1), crediting said at least one higher education account with said rebate (col. 1 lines 26-31 and 42-46), wherein said rebate is provided by said at least one registered merchant (col. 4 lines 57-60).

¹ Lidman and Schultz et al. were respectively made of record 15 December 2003 and 8 October 2004.

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8. The merchant/store **20** participates in the method by permitting use of its *store coupons and store increases of manufacturer's coupons* and permitting transfers from the store's account **132** to the registered member/purchaser's account **50** at bank **130** (col. 3 lines 4-13). By virtue of having an account with said bank **130**, said merchant/store must be enrolled in the records of bank **130**, which makes it a merchant/store registered with bank **130** (Merriam-Webster's Online Dictionary definition of "register")².
9. Lidman does not teach that said computer processor is located at location other than the location of the merchant. Schultz et al. teaches that said computer processor (*PMCS 4*, col. 5 lines 44-56) is located at location other than the location of the merchant. Because Schultz et al. teaches that this allows the invention to service multiple *retail outlets 20 of different retail chains*, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Schultz et al. to those of Lidman.
10. Lidman does not teach that the rebate ranges from 0.01% to 30% of each transaction or (claims 13 and 31) purchases made on-line. Official notice of these common knowledge or well known in the art statements were taken in the Office action mailed on 15 December 2003 (para. 17 of paper No. 6). These statements are taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.)
11. Lidman also teaches at the citations given above claims 4, 5-7, 8, 11, 14, 15, 25, 30 and 32.
12. Lidman also teaches at the citations given above claims 16 and 29, where the bank **130** that is the custodian of *customer account 50* and *store account 132* reads on a registration organization, which must obviously be paid (receives a portion of said rebate). Lidman also teaches claims 12 and 27 (col. 3 line 38).
13. Neither reference teaches (claim 49) transferring funds from said educational account to make payments on education loans and/or debt. However, that is, by definition, the only and therefore obvious purpose of the educational savings account taught by Lidman. Dependent claims 51 and 52 are similarly obvious because "a second computer processor" is interpreted as any arbitrary computer processor used in the Lidman network by the bank **150** to make said educational payments.

² Made of record by the examiner 8 October 2004.

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14. Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references cited above and further in view of Simpson (US006070153A)³. The references cited above do not teach an educational IRA account. Simpson teaches an educational IRA account (col. 1 line 49). Because of the tax-deferral advantages of an IRA, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Simpson to those of the references cited above.

Consideration of Disclosed Limitations for Patentability

15. Claiming any of the five limitations discussed in an interview on 4 December 2007 would not make the claims patentable for the following reasons.
- (1) Both debit and credit cards are taught by Lidman (col. 3 line 38). Lidman also teaches the rebate coming from the merchant only (col. 4 lines 57-60).
 - (2) Multiple types of merchants with multiple (variable) rebates: Higgins⁴ teaches rebates of 1-3% of credit card purchase amounts. *Ebates* and *BizRate* teach rebates of "up to 25%" from a variety of merchants. Simpson also teaches a credit-card based system with a variety of rebate options (col. 4 line 45 to col. 5 line 8 and Fig. 3).
 - (3) Pay existing debt: The examiner did not find any teaching of using rebates expressly to pay existing educational debt. However, it was common for many people at the time of the instant invention, including the examiner, to receive rebates (using a "cash back" credit card, for example) and to simultaneously pay existing educational debt. The rebates for many people were in fact substantively linked to payment of existing educational debt because the (checking) account into which the rebates were deposited was also used to pay the educational debt. Rebates were linked to educational debt payment in all except name. Giving a new name to an existing process is not inventive.
 - (4) Quick posting of rebates: Lidman teaches this (col. 4 lines 4-7).
 - (5) Capturing information on individual transactions: That is inherent with any credit-card system, such as that taught by Simpson. Indeed, even the coupon-based system of Lidman must acquire information on each individual transaction. Furthermore, Lidman teaches that the purchaser would receive a periodic account statement similar to that of

³ Simpson was made of record with the Office action mailed on 19 January 2007.

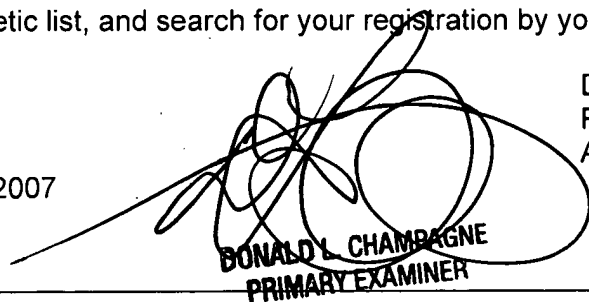
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any other bank account (col. 4 lines 61-67). It is obvious that the rebate transactions could be itemized just as other bank transactions are.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
17. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.
18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
19. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

14 December 2007



DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

⁴ Higgins (non-patent literature) was made of record 15 December 2003.